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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL E. MCHENRY, IRWIN L. GOLDBLATT, CHARLES S. SEYMOUR, MYRON G. BROWN and ANTHONY D. SMITH

Appeal 2008-4068
Application 09/829,393
Technology Center 3600

Decided: December 31, 2008

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Michael E. McHenry, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-32 and 34. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.¹

THE INVENTION

The invention relates to a method of using a computer network to recommend or customize engine oil for a motor vehicle. (Specification 1: 14-16.) Based on a user's inputted data, engine oil is either recommended or designed. (Specification 2: 5-7.) The engine oil is then sold and either directly or indirectly sent to the user. (Specification 2: 7-12.)

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method of obtaining motor vehicle engine oil having user desired characteristics by using a wide area computer network by:

- (a) obtaining and inputting data from a user, including type information about the motor vehicle in which the engine oil is to be utilized sufficient to identify a user's requirements;
- (b) analyzing the data by computer; and
- (c) responsive to (b) providing a motor vehicle engine oil having recommended, or user desired enhancements;

wherein (a)-(c) are practiced to allow a customer to participate in the design, selection or customization of a particular motor oil to fit that customer's needs.

¹ Our decision will make reference to the Appellants' Appeal Brief ("Br.," filed May 18, 2007) and the Examiner's Answer ("Answer," mailed Aug. 24, 2007).

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Lustig	US 4,230,502	Oct. 28, 1980
Kay	US 4,303,597	Dec. 1, 1981
Denis	US 4,954,273	Sep. 4, 1990
Osborn	US 6,182,048 B1	Jan. 30, 2001

Anon., "Ford Issues Winter Car Care Alert," PR Newswire, Jan. 8, 1988. (Herein after Ford.)

Wilkinson, T., "Understanding What's in Your Car's Motor Oil," Consumers' Research Magazine, Vol. 25, No. 8, p. 20, Aug. 1992. (Herein after Wilkinson.)

Klepaki, L., "Reflect to Mirror Users," Women's Wear Daily, Vol. 178, No. 99 (Nov. 19, 1999), pg. 10. (Herein after Klepaki.)

Anon., "Drive Green Tips," PR Newswire, Apr. 10, 1990. (Herein after Drive Green.)

McHenry et al., the instant application, page 2, lines 13-24. (Herein after Admitted Prior Art.)

Levine, J., "The Ultimate Sell" (Abstract), Forbes, Vol. 147, No. 10 (May 13, 1991) pages 108 and 110.

Marti, M.E. "Phyto-Active Chemicals" (Abstract), Drug & Cosmetic Industry, Vol. 150, No. 2 (Feb. 1992), pp. 36 and 41-46.

Anon., "PCN Shows how to Virtually Market and Deliver," Interactive Marketing News, Jul. 5, 1996.

Zambiazi, R.C., "The Role of Endogenous Lipid Components on Vegetable Oil Stability" (Abstract), Dissertation Abstracts International, Vol. 58/11B, p. 5720 (1997).

Nash, S., "More Free PC's," PC Magazine, Vol. 30, No. 1, May 25, 1999.

Anon., "Netzero," The IPO Reporter, Sep. 20, 1999.

The following rejections are before us for review:

1. Claims 1 and 2 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ford in view of Osborn.
2. Claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ford in view of Osborn and further in view of Wilkinson.
3. Claims 4, 5 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ford in view of Osborn and further in view of Klepacki.
4. Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ford in view of Osborn and further in view of Klepacki and Official Notice.
5. Claims 8-12, 14, 15, 16, 21 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ford in view of Osborn and Klepacki and further in view of Denis.
6. Claim 13 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ford in view of Osborn, Klepacki, Denis and further in view of Official Notice.
7. Claims 17, 18, 19 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ford in view of Osborn, Klepacki, Denis and further in view of Official Notice.
8. Claim 34 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ford in view of Osborn and further in view of Admitted Prior Art.

9. Claims 23-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Klepacki in view of Wilkinson, Drive Green and Official Notice.
10. Claims 29-32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Klepacki in view of Wilkinson, Drive Green, Official Notice and Denis.

ISSUES

The first issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 1 and 2 under 35 U.S.C. § 103(a) as unpatentable over Ford in view of Osborn. Specifically, does the combination of Ford and Osborn lead one of ordinary skill in the art to a combination having all of the limitations of claim 1?

The second issue before us is whether the Appellants have shown that the Examiner erred in rejecting claim 3 under 35 U.S.C. § 103(a) as unpatentable over Ford in view of Osborn and Wilkinson. Specifically, does the combination of Ford, Osborn and Wilkinson lead one of ordinary skill in the art to a combination having all of the limitations of claim 3?

The third issue before us is whether the Appellants have shown that the Examiner erred in rejecting claim 6 under 35 U.S.C. § 103(a) as unpatentable over Ford in view of Osborn and Klepacki. Specifically, does the combination of Ford, Osborn and Klepacki lead one of ordinary skill in the art to a combination having all of the limitations of claim 6 and further, is Klepacki analogous art?

The fourth issue before us is whether the Appellants have shown that the Examiner erred in rejecting claim 7 under 35 U.S.C. § 103(a) as

unpatentable over Ford in view of Osborn, Klepacki and Official Notice. Specifically, does the combination of Ford, Osborn, Klepacki and Official Notice one of ordinary skill in the art to a combination having all of the limitations of claim 7?

The fifth issue before us is whether the Appellants have shown that the Examiner erred in rejecting claim 34 under 35 U.S.C. § 103(a) as unpatentable over Ford in view of Osborn and Admitted Prior Art. Specifically, does the combination of Ford, Osborn, Klepacki and Official Notice lead one of ordinary skill in the art to a combination having all of the limitations of claim 34?

The sixth issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 4-5 under 35 U.S.C. § 103(a) as unpatentable over Ford in view of Osborn and Klepacki. Specifically, does the combination of Ford, Osborn and Klepacki lead one of ordinary skill in the art to a combination having all of the limitations of claim 4 and further, is Klepacki analogous art?

The seventh issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 8-12, 14-16 and 21-22 under 35 U.S.C. § 103(a) as unpatentable over Ford in view of Osborn, Klepacki and Denis. Specifically, does the combination of Ford, Osborn, Klepacki and Denis lead one of ordinary skill in the art to a combination having all of the limitations of claim 8?

The eighth issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 13 and 17-20 under 35 U.S.C. § 103(a) as unpatentable over Ford in view of Osborn, Klepacki, Denis and Official Notice. Specifically, does the combination of Ford, Osborn,

Klepaki, Denis and Official Notice render obvious the improvement range of 0.1-100% in claim 13?

The ninth issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 23-26 under 35 U.S.C. § 103(a) as unpatentable over Klepacki in view of Wilkinson, Drive Green and Official Notice. Specifically, does the combination of Klepacki, Wilkinson, Drive Green and Official Notice lead one of ordinary skill in the art to a combination having all of the limitations of claim 23?

The tenth issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 27-32 under 35 U.S.C. § 103(a) as unpatentable over Klepacki in view of Wilkinson, Drive Green, Official Notice and Denis. Specifically, does the combination of Klepacki, Wilkinson, Drive Green, Official Notice and Denis lead one of ordinary skill in the art to a combination having all of the limitations of claim 27?

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

Claim construction

1. Claim 1 recites “A method of obtaining motor vehicle engine oil having user desired characteristics.”
2. Claim 1 recites “(a) obtaining an inputting data from a user, including type information about the motor vehicle in which the

engine oil is to be utilized sufficient to identify a user's requirements".

3. Claim 1 recites, "(b)" analyzing the data by computer".
4. Claim 1 recites "(c) responsive to (b) providing a motor vehicle engine oil having recommended, or user desired enhancements." The claim does not require a supplier, which provides the motor vehicle engine oil. The claim does not place any limitation as to who is performing the step.
5. Claim 1 also recites, "wherein (a)-(c) are practiced to allow a customer to participate in the design, selection or customization of a particular motor oil to fit that customer." This limitation is broad enough to encompass selecting an existing motor oil that already meets the user's desired enhancements.
6. Claim 4 recites steps (a)-(c) above from claim 1.
7. Claim 4 recites, "wherein (a)-(c) are practiced to design, produce, and deliver or make available, a customized engine oil and to allow a customer to participate in the design, selection or customization of a particular motor oil to fit that customer's needs."
8. Claim 23 recites a method of obtaining custom engine oil.
9. Claim 23 recites, "(a) using an implement to transmit information from a user about the user's motor vehicle type, environment of use, and desired operational characteristics, to a customized blending facility."
10. Claim 23 recites, "(b) blending a custom engine oil using the information form (a)".

11. Claim 23 recites, “(c) delivering to, installing or making available for pickup by the user from step (a) the custom engine oil blended in step (b).”

The scope and content of the prior art

Ford

12. Ford relates to winter car care tips, including using the proper engine oil. (Pg. 1.)
13. Ford states, “Use the proper engine oil.” (Pg. 1.)
14. Ford states, “Owners should check their owner guides for specific oil recommendations.” (Pg. 1.)
15. Most manufacturers specify 5W-30 motor oil, which improves cold-weather starting while providing better fuel economy and performance. (Ford Pg. 1.)

Osborn

16. Osborn relates to an automated method of selecting and selling insurance. (Col. 1, ll. 6-9.)
17. Osborn describes that the insurance policy can be for a vehicle warranty. (Col. 2, ll. 60-62.)
18. Osborn’s method uses a computer and processor connected by a computer network. (Col. 2, ll. 65-66.)
19. Osborn describes that the customer requests a policy for a particular vehicle to the processor. (Col. 2, l. 66 – Col. 3, l. 1.)
20. Osborn describes that the request includes information, such as vehicle make, model, year, VIN, mileage, and region of operation. (Col. 3, ll. 1-5.)

21. Osborn describes that the processor prices a policy and describes terms and conditions based on the request. (Col. 3, ll. 11-13.)
22. Osborn describes that the policy may then be communicated and offered for sale to the customer. (Col. 3, ll. 16-19.)
23. Osborn describes that a telephone, the mail or the Internet may be used to make the request. (Col. 3, ll. 5-10.)

Wilkinson

24. Wilkinson relates to motor oil for vehicles.
25. Wilkinson states,

What Experts Recommend. Ask almost any carmaker what grade oil you should use and the answer comes back the same: a 5W-30 or 10W oil with an API SG service rating, preferably one that also carries the Energy Conserving II label.

Generally, 5W-30 is recommended for really cold weather, while 10W-30 is the choice when the weather warms. A few carmakers still allow the use of 15W-40 or 20W-50 when things get really hot.

(Pg. 3)

Klepaki

26. Klepaki relates to a method of ordering customized beauty products from a website. (Pg. 1.)
27. Klepaki describes creating a formula of shampoo based on variables, such as thickness of hair or type of scent the customer prefers. (Pg. 1.)
28. Klepaki describes asking visitors to a website various questions and then offering options based on the responses. (Pg. 1-2.)
29. Klepaki describes that product is delivery. (Pg. 2.)

Denis

30. Denis relates to crank case oil formulations having an additive component. (Col. 1, ll. 12-16.)
31. Denis states, “The additive component is present in sufficient amounts so as to provide improved performance characteristics to the composition such as pH stability, water tolerance and antiwear characteristics.” (Abstract.)
32. Denis also states, “In crank case oil compositions the additive provides a number of improved performance properties, most importantly improved detergent capabilities (resulting in cleaner engine parts) and improved frictional properties (resulting in improved fuel efficiency.)” (Abstract.)

Drive Green

33. Drive Green relates to making car eco-friendly. (Pg. 1)
34. Drive Green describes using a high-quality oil to reduce engine sludging and improve fuel economy. (Pg. 1)

Any differences between the claimed subject matter and the prior art

35. Ford does not describe using a wide area computer network or computer to provide recommended motor oil.
36. Ford does not describe customizing motor oil products.
37. Klepacki does not describe motor oil as a product instead of cosmetics.

The level of skill in the art

38. Neither the Examiner nor the Appellants has addressed the level of ordinary skill in the pertinent art of creating or recommending customizing motor oil using e-commerce. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (Quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).
39. One of ordinary skill in the art would know that in order to use motor engine oil in a vehicle, the engine motor oil would have to first be provided.
40. One of ordinary skill in the art would know to select an improved engine motor oil, including one which improves, for example, wear performance.

Secondary considerations

41. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004). “[W]e look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation. As this court has discussed, this methodology produces claims with only justifiable breadth. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). Further, as applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee. Am. Acad., 367 F.3d at 1364.” *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007). Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383

U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

ANALYSIS

The rejection of claims 1 and 2 under § 103(a) as being unpatentable over Ford in view of Osborn

We give claim 1 the broadest reasonable construction in light of the Specification as it would be interpreted by one of ordinary skill in the art. Claim 1 describes a method of obtaining a motor oil comprising the steps of (a) obtaining and inputting data from a user, (b) analyzing the data by a computer, and (c) providing a oil responsive to (b). The steps allow a customer to participate in the design, selection *or* customization of a motor oil. Claim 1 is not limited to customizing a motor oil and is broad enough to encompass selecting an existing motor oil that already has the user’s desired enhancements.

The Examiner has taken the position that Ford describes a method of providing a recommended engine motor oil based on the type of motor vehicle and that Osborn describes analyzing motor vehicle information by computer. (Answer 4-5.) The Examiner concluded that “it would have been obvious to one having ordinary skill in the art of electronic commerce at the time of applicant’s invention to analyze the data by computer, and provide an engine oil responsive to the data analysis, for the obvious advantage of

using a computer for calculations that may be difficult or time-consuming for human beings to perform (Answer 5)."

We have carefully reviewed the record and find that the Examiner has established a *prima facie* case of obviousness that includes an articulation of an apparent reasoning to combine the references which would lead one of ordinary skill in the art to the invention as claimed and one that is logically underpinned.

The Appellants argue that neither Ford nor Osborn describes all of the limitations of claim 1. Appellants state that Ford does not describe interaction between the customer and supplier to provide oil having user desired characteristics and Osborn is not directed to motor oils. (Br. 14.)

Obviousness requires "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). "The first issue we address with respect to obviousness is the scope and content of the prior art—specifically whether the prior art exhibited every step of the methods claimed in independent claims 1 and 31 of the '099 patent." *Miniauction, Inc. v. Thomson Corp.*, F.3d (Fed. Cir. 2008). Appellants have not addressed the combination of prior art references *as a whole* but simply improperly argues the merits of each reference individually. See *In re Keller*, 642 F.2d 413, 425 (CCPA 1981); *In re Young*, 403 F.2d 754, 757-58 (CCPA 1968).

We agree with the Examiner that the combination of Ford and Osborn would lead one of ordinary skill to the elements of claim 1. Ford describes using a recommended motor oil, (FF 12-15) which is determined manually by an owner by looking in an owner's manual for the specific type of vehicle

(FF 14). Further, in evaluating such references it is proper to take into account not only the specific teachings of the references, but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826 (CCPA 1968). One of ordinary skill in the art would know that in order to use the proper motor oil in a vehicle, the motor oil would have to be provided. (FF 39.)

Osborn describes a method of obtaining a vehicle warranty insurance policy. The method includes the automated steps of obtaining and inputting data from a user (FF 19-20), analyzing the data by computer (FF 18 and 21), and providing a recommended product (FF 22).

Applying the automated method of obtaining a product in Osborn to the product (i.e. motor oil) in Ford would lead one of ordinary skill in the art to the method of claim 1. Therefore, we hold that the Appellants have not shown that the Examiner failed to establish a *prima facie* showing of obviousness and that the Appellants have not shown that the Examiner erred in rejecting claims 1 and 2.

The rejection of Claim 3 under § 103(a) as being unpatentable over Ford in view of Osborn and Wilkinson.

Again, the Appellants argue that all elements of claim 1 are not found in either Ford or Osborn. Claim 3 depends upon claim 1. Further, the Appellants argue that adding Wilkinson still does not lead one of ordinary skill in the art to the method of claim 1. (Br. 16.)

As explained above with regard to the rejection of claim 1, we find that the combination of Ford and Osborn leads one of ordinary skill in the art to the method of claim 1. Claim 3 depends from claim 1 and further limits

the type of information inputted in step (a) to be “at least one of expected ambient temperatures, average driving distance, normal type of driving, and interest in fuel economy, cold weather starting, and engine longevity.” Wilkinson describes recommending motor oil based on weather conditions, including cold weather. (FF 24-25.)

Therefore, we hold that the Appellants have not shown that the Examiner erred in rejecting claim 3.

The rejection of Claim 6 under § 103(a) as being unpatentable over Ford in view of Osborn and Klepacki.

The Appellants argue that Klepacki is non-analogous art since Klepacki relates to cosmetics, skin care, and hair care products. (Br. 17-18.) The Examiner contends that Klepacki is pertinent to the problem with which the Appellants were concerned, “namely gathering information about a particular customer’s need or wants so as to provide a customized product (Answer 17).”

“The analogous-art test requires that the Board show that a reference is either in the field of the applicant’s endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection. References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art.” *In re Kahn*, 441 F.3d 977, 986-87 (Fed. Cir. 2006). “A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” *In re Clay*, 966

F.2d 656, 659 (Fed. Cir. 1992). “When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one.” *KSR Int’l, Inc. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740 (2007).

We find that Klepacki is reasonably pertinent to the particular problem being solved by the Appellants. Appellants’ problem is creating an interactive website for customization of products based on the customer’s needs. (Specification 1: 8-17.) Klepacki is concerned with an Internet site that allows a customer to customize a product. (FF 26.) Therefore, we find that Klepacki is analogous art and that Appellants have not shown that the Examiner erred in rejecting claim 6.

In addition, the Appellants again argue that all elements of claim 1 are not found either Ford or Osborn. Claim 6 depends upon claim 1. Further, the Appellants argue that adding Klepacki still does not lead one of ordinary skill in the art to the method of claim 1. (Br. 16.) The Examiner cited Klepacki for the limitations of dependent claim 6. Therefore, we hold that the Appellants have not shown that the Examiner erred in rejecting claim 6.

The rejection of Claim 7 under § 103(a) as being unpatentable over Ford in view of Osborn, Klepacki and Official Notice.

Again, the Appellants argue that all elements of claim 1 are not found in either Ford or Osborn. Claim 7 depends upon claim 1. Further, the Appellants argue that adding Klepacki and Official Notice still does not lead one of ordinary skill in the art to the method of claim 1. (Br. 19.)

The Examiner took Official Notice that the limitations of dependent claim 7 were known at the time of the invention and the Appellants do not

traverse the Examiner's use of Official Notice. (Br. 17-18.) As explained above with regard to the rejection of claim 1, we find that the combination of Ford and Osborn would lead one of ordinary skill in the art to the method of claim 1. Therefore, we find that the Appellants have not shown that the Examiner erred in rejecting claim 7.

The rejection of Claims 4 and 5 under § 103(a) as being unpatentable over Ford in view of Osborn and Klepacki.

The Appellants argued claims 4 and 5 as a group (Br. 19). We select claim 4 as the representative claim for this group, and the remaining claim 5 stands or falls with claim 4. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

We give claim 4 the broadest reasonable construction in light of the Specification as it would be interpreted by one of ordinary skill in the art. Claim 4 recites the same steps (a)-(c) as recited in claim 1. However, claim 4 recites that the steps are practiced to design, produce, and deliver or make available, a customized engine oil. Claim 4 is directed to customization of engine oil and not selection.

The Examiner has taken the position that the combination of Ford and Osborn leads one of ordinary skill in the art to steps (a)-(c) and that it is well known to make custom blend of mixed materials as evidenced by Klepacki. (Answer 19). The Examiner concludes that it would have been obvious to one of ordinary skill in the art to practice steps (a)-(c) to design, produce, and deliver or make available a customized engine oil, for the advantage of "customizing the oil to best suit a particular user." (Answer 6.)

We have carefully reviewed the record and find that the Examiner has established a *prima facie* case of obviousness that includes an articulation of

an apparent reasoning to combine the references which would lead one of ordinary skill in the art to the invention as claimed and one that is logically underpinned.

The Appellants argue that none of Ford, Osborn or Klepacki describes a method wherein the steps are “practiced to design, produce, and deliver or make available, a customized engine oil and to allow a customer to participate in the design, selection or customization of a particular motor oil to fit that customer’s need.” (Br. 19.) Appellants argue that Ford does not describe *customizing* motor oil to impart characteristics desired by a particular user and that both Osborn and Klepacki are not related to motor oils. (Br. 18.)

We however agree with the Examiner that the combination of Ford, Osborn, and Klepacki would lead one of ordinary skill to the method of claim 4 because, e.g., Klepacki describes customizing the characteristics of a liquid product based on a customer’s preferences. (FF 26-27.) Therefore, we hold that the Appellants have not shown that the Examiner failed to establish a *prima facie* showing of obviousness and that the Appellants have not shown that the Examiner erred in rejecting claim 4.

Next, the Appellants again argue that Klepacki is non-analogous art. As explained above with regard to the rejection of claim 6, we find Klepacki to be analogous art.

Therefore, we find that the Appellants have not shown that the Examiner erred in rejecting claims 4 and 5.

The rejection of Claims 8-12 under § 103(a) as being unpatentable over Ford in view of Osborn, Klepacki and Denis.

The Appellants argued claims 8-12 as a group (Br. 20). We select claim 8 as the representative claim for this group, and the remaining claims 9-12 stand or fall with claim 8. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

Next, the Appellants argue that all elements of claim 4 are not found in Ford, Osborn or Klepacki. Claim 8 depends upon claim 4. Further, the Appellant argues that adding Denis still does not lead one of ordinary skill in the art to the method of claim 4. (Br. 22.)

The Examiner cited Denis for the additional limitations of dependent claim 8. As explained above with regard to the rejection of claim 4, we find that the combination of Ford, Osborn and Klepacki would lead one of ordinary skill in the art to the method of claim 4. Therefore, we find that the Appellants have not shown that the Examiner erred in rejecting claims 8-12.

The rejection of claims 14-16 and 21 under § 103(a) as being unpatentable over Ford in view of Osborn, Klepacki and Denis.

The Appellants argued claims 14-16 and 21 as a group (Br. 22). We select claim 14 as the representative claim for this group, and the remaining claims 15-16 and 21 stand or fall with claim 14. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

Again, the Appellants argue that all elements of claim 4 are not found in Ford, Osborn or Klepacki. Claim 14 depends upon claim 4. Further, the Appellants argue that adding Denis still does not lead one of ordinary skill in the art to the method of claim 4. (Br. 23-25.)

The Examiner cited Denis for the additional limitations of dependent claim 14. As explained above with regard to the rejection of claim 4, we find that the combination of Ford, Osborn and Klepacki would lead one of

ordinary skill in the art to the method of claim 4. Therefore, we find that the Appellants have not shown that the Examiner erred in rejecting claims 14-16 and 21.

The rejection of claim 13 under § 103(a) as being unpatentable over Ford in view of Osborn, Klepacki, Denis and Official Notice.

First, the Appellants argue that the Examiner has not established a *prima facie* case of obviousness for claim 13 because none of the references cited, including Marti, Zambizi and Lustig, describe an improvement in fuel economy, wear performance, detergent performance, dispersant performance, oxidation protection, corrosion protection, low temperature performance or blend stability by customizing the motor oil in the range of 0.1-100%. (Br. 24.)

The Examiner's position is that Denis teaches adding additives to motor oil to improve the characteristics recited in claim 13 and finds the claimed range of 0.1-100% obvious. (Answer 19.) The Examiner further states:

The reasonable presumption is that one would not go to the trouble of attempting to determine optimal quantities of various additives, and the expense of adding these additives, as taught in Denis and other art of record, unless these additives produced non-trivial improvement in the properties that they were intended to improve. Indeed, one would hardly identify a chemical as, for example, an antiwear additive unless its effects on preventing wear were detectable without extreme effort, imply an improvement greater than 0.1%.

(Answer 9.)

“A *prima facie* case of obviousness may be made when the only difference from the prior art is a difference in the range or value of a particular variable. *In re Peterson*, 315 F.3d 1325, 1329 (Fed. Cir. 2003); *In re Woodruff*, 919 F.2d 1575, 1578 (Fed. Cir. 1990).” *In re Kumar*, 76 USPQ2d 1048, 1051 (Fed. Cir. 2005). “Where “the difference between the claimed invention and the prior art is some range or other variable within the claims . . . , the [patentee] must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results.” *Woodruff*, 919 F.2d at 1578. “We have also held that a *prima facie* case of obviousness exists when the claimed range and the prior art range do not overlap but are close enough such that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 783, 227 USPQ 773, 779 (Fed. Cir. 1985) (concluding that a claim directed to an alloy containing “0.8% nickel, 0.3% molybdenum, up to 0.1% maximum iron, balance titanium” would have been *prima facie* obvious in view of a reference disclosing alloys containing 0.75% nickel, 0.25% molybdenum, balance titanium and 0.94% nickel, 0.31% molybdenum, balance titanium).” *In re Peterson*, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003).

We agree with the Examiner that Denis discloses the claimed range of 0.1-100% improvement. Denis discloses that motor oil additives improve pH stability, water tolerance, and antiwear characteristics. (FF 30-32.) The resulting oil exhibits an improvement in these characteristics over a motor oil without the additives. One of ordinary skill reading Denis would understand that the measurable improvement in these characteristics would cover a range that necessarily exceeds 0%. Given this, we find that Denis

encompasses the claimed range of 0.1-100% but nevertheless renders obvious the low end of the claimed range (0.1%) because Denis teaches an improvement, including a slight improvement, necessarily exceeding 0% which one skilled in the art would have expected to be the same. In that regard, the Appellants have not provided any evidence of unexpected results for the claimed range. (FF 41.) Accordingly, we find that one of ordinary skill in the art at the time the invention would have found the subject matter of claim 13 obvious in view of Denis.

Next, the Appellants argue that all elements of claim 4 are not found Ford, Osborn or Klepacki. Claim 34 depends upon claim 4. Further, the Appellants argue that adding Denis still does not lead one of ordinary skill in the art to the method of claim 4. (Br. 23-25.)

The Examiner cited Denis for the additional limitations of dependent claim 13. As explained above with regard to the rejection of claim 4, we find that the combination of Ford, Osborn and Klepacki would lead one of ordinary skill in the art to the method of claim 4. Therefore, we find that the Appellants have not shown that the Examiner erred in rejecting claim 13.

The rejection of claims 17-20 under § 103(a) as being unpatentable over Ford in view of Osborn, Klepacki, Denis and Official Notice.

The Appellants argue against the rejection of claims 17-20 for the same reasons used to argue against the rejection of claim 13. (Br. 25-27). For the reasons we found these same arguments unpersuasive as to the rejection of claim 13, we find them equally unpersuasive as to error in the rejection of claims 17-20.

Therefore, we find that the Appellants have not shown that the Examiner erred in rejecting claims 17-20.

The rejection of claim 34 under § 103(a) as being unpatentable over Ford in view of Osborn and Admitted Prior Art.

Again, the Appellants argue that all elements of claim 1 are not found in either Ford or Osborn. Specifically, the Appellants argue that “[n]either Ford nor Osborn suggests a method for permitting a consumer to obtain motor vehicle engine oil having characteristics desired by the consumer by using a wide area computer network by: [steps (a)-(c) of claim 1]”. (Br. 27-28.) In effect, the Appellants are repeating the argument made in challenging the rejection of claim 1 in that the cited art combination would not lead one of ordinary skill in the art to the subject matter of claim 1. For the same reasons given *supra* in sustaining the rejection of claim 1, we find that the combination of Ford and Osborn would lead one of ordinary skill in the art to the method of claim 34. Thus, we find that the Appellants have not shown that the Examiner erred in rejecting claim 34.

We should point out that, although the Brief was filed (May 18, 2007) after the decision in *KSR* was issued (April 30, 2007), the Brief advocates applying the strict standard of obviousness prevalent in patent prosecution practice prior to *KSR*'s issuance. For instance, the Appellants argue that the “requisite motivation to combine references must come from the prior art” (Br. 27) and “[t]here must be a reason or suggestion in the art for selecting the procedure used” (Br. 27). *KSR* clarified the standard of obviousness. “As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for

a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR* at 1741. “The obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents. The diversity of inventive pursuits and of modern technology counsels against limiting the analysis in this way. In many fields it may be that there is little discussion of obvious techniques or combinations, and it often may be the case that market demand, rather than scientific literature, will drive design trends. Granting patent protection to advances that would occur in the ordinary course without real innovation retards progress and may, in the case of patents combining previously known elements, deprive prior inventions of their value or utility.” *KSR* at 1741. To establish a prima facie case of obviousness, therefore, the references being combined do not need to explicitly suggest combining their teachings. *See also In re Kahn*, 441 F.3d 977, 987-88 (Fed. Cir. 2006) (“the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references”); *In re Johnston*, 435 F.3d 1381, 1385 (Fed. Cir. 2006) (“An explicit teaching that identifies and selects elements from different sources and states that they should be combined in the same way as in the invention at issue, is rarely found in the prior art”); and *In re Nilssen*, 851 F.2d 1401, 1403 (Fed. Cir. 1988) (“for the purpose of combining references, those references need not explicitly suggest combining teachings.”). The question here is whether the Examiner has articulated an apparent reasoning for combining the prior art to arrive at the claimed subject matter. “Often, it will be necessary for a court to look to interrelated teachings of multiple patents;

the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F.3d 977, 988 (C.A.Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). *KSR* at 1740-1741. As we stated earlier in this decision, after careful review of the record, we find that the Examiner did include an articulation of an apparent reasoning to combine the references which would lead one of ordinary skill in the art to the invention as claimed and one that appears to be logically underpinned that would support establishing a *prima facie* case of obviousness of the claimed subject matter over the combined prior art. In that regard, the Appellants have not challenged the merits of that reasoning nor shown an error in the logic underpinning that reasoning. Accordingly, the arguments made in the Brief with respect to the rejection of claim 34 are not persuasive as to error in its rejection.

The rejection of Claims 23-26 under § 103(a) as being unpatentable over Klepacki in view of Wilkinson, Drive Green and Official Notice.

The Appellants argue claims 23-26 as a group (Br. 28). We select claim 23 as the representative claim for this group, and the remaining claims 24-26 stand or fall with claim 23. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

We give claim 23 the broadest reasonable construction in light of the Specification as it would be interpreted by one of ordinary skill in the art. Claim 23 recites a method of obtaining custom engine oil by (a) transmitting information about a user's motor vehicle type, environment of use, and desired operational characteristics to a blending facility, (b) blending the custom engine oil and (c) delivering, installing or making available the custom engine oil.

The Examiner contends that Klepacki describes a user transmitting information used to blend a custom product, that Wilkinson describes selecting an engine oil based on environment of use and motor vehicle type, and that Drive Green describes selecting an engine oil based on desired operational characteristics. (Answer 11.) The Examiner concludes that it would have been obvious to one of ordinary skill in the art to blend an engine oil for the advantage of "providing a suitable product in accordance with the user's particular needs." (Answer 11-12.) Further, the Examiner takes Official Notice that it is well known to deliver or make available products ordered by users. (Answer 12.)

We have carefully reviewed the record and find that the Examiner has established a prima facie case of obviousness that includes an articulation of an apparent reasoning to combine the references which would lead one of ordinary skill in the art to the invention as claimed and one that is logically underpinned.

The Appellants argue that the Examiner has failed to establish a prima facie case of obviousness because the combination of Klepacki, Wilkinson and Drive Green do not teach all of the limitations of claim 23 since 1) Klepacki does not relate to motor oil and 2) Wilkinson and Drive Green do

not teach blending custom motor oils because on a customers participation. (Appeal Br. 29,30).

We agree with the Examiner that all of the limitations of claim 23 are found in Klepacki, Wilkinson and Drive Green. Klepacki describes a method of creating a custom product by having a user input information (FF 26-29), blending a custom product for the user (FF 27), and delivering the product (FF 29). Wilkinson describes selecting motor oil based on environment of used and motor vehicle type (FF 24-25) and Drive Green describes selecting a motor oil based on desired operational characteristics (FF 33-34).

Finally, the Appellants argue “the Examiner does not provide any evidence to support the taking of official notice that it is well known for e-commerce websites to deliver or make available products ordered by users.” (Br. 29.) However, Klepacki describes delivering customized products to customers. (FF 29.)

Therefore, we find that the Appellants have not shown that the Examiner erred in rejecting claim 23-26.

The rejection of Claims 27-32 under § 103(a) as being unpatentable over Klepacki in view of Wilkinson, Drive Green, Official Notice and Denis.

The Appellants argue against the rejection of claims 27-32 for the same reasons used to argue against the rejection of claim 23. (Br. 31-32). For the reasons we found these same arguments unpersuasive as to the rejection of claim 23, we find them equally unpersuasive as to error in the rejection of claims 27-32.

Therefore, we find that the Appellants have not shown that the Examiner erred in rejecting claims 27-32.

CONCLUSIONS OF LAW

We conclude that the Appellants have not shown that the Examiner erred in rejecting:

Claims 1 and 2 as unpatentable over Ford in view of Osborn;

Claim 3 as unpatentable over Ford in view of Osborn and further in view of Wilkinson;

Claims 4, 5 and 6 as unpatentable over Ford in view of Osborn and further in view of Klepacki;

Claim 7 as unpatentable over Ford in view of Osborn and further in view of Klepacki and Official Notice;

Claims 8-12, 14, 15, 16, 21 and 22 as unpatentable over Ford in view of Osborn and Klepacki and further in view of Denis;

Claims 13 and 17-20 as unpatentable over Ford in view of Osborn, Klepacki, and Denis and further in view of Official Notice;

Claim 34 as unpatentable over Ford in view of Osborn and further in view of Admitted Prior Art.

Claims 23-26 as unpatentable over Klepacki in view of Wilkinson, Drive Green and Official Notice; and

Claims 27-32 as unpatentable over Klepacki in view of Wilkinson, Drive Green, Official Notice and Denis.

DECISION

The decision of the Examiner to reject claims 1-32 and 34 is affirmed.

Appeal 2008-4068
Application 09/829,393

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

jrg

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